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United States Patent and Trademark Office

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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/545,962

04/10/00

MAJOR

W

556285010101

DAVID B COCHRAN F50
JONES DAY REAVIS & POQUE
NORTH POINT
701 LAKESIDE AVENUE
CLEVELAND OH 44114

WM01/0424

EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

04/24/01

Response due

July 24, 2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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APR 27 2001

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Office Action Summary

Application No.

09/545,962

Applicant(s)

MAJOR ET AL.

Examiner

Bradley Edelman

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 21 and 22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6,7.
- 18) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Interview Summary

Application No.

09/545,962

Applicant(s)

MAJOR ET AL.

Examiner

Bradley Edelman

Art Unit

2153

All participants (applicant, applicant's representative, PTO personnel):

(1) Bradley Edelman.

(3) _____.

(2) David Cochran.

(4) _____.

Date of Interview: 19 April 2001.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description:

Claim(s) discussed: 1-22.

Identification of prior art discussed: none.

Agreement with respect to the claims f) ☒ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner stated that claims 1-20, claim 21, and claims 22 comprised three respective restrictable inventions. Applicant agreed to elect claims 1-20 without traverse.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to a system for notifying a user of replicated messages received at a mobile communication device, classified in class 340, subclass 7.59.
- II. Claim 21, drawn to a system for automatically generating a reply message, according to priority, to messages received at a mobile device, classified in class 709, subclass 206.
- III. Claim 22, drawn to a method for routing attachments sent to mobile communication devices, classified in class 709, subclass 238.

The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as notifying visually impaired pager users of incoming messages, invention II has separate utility such as sending auto-response messages for high-priority messages, and invention II has separate utility such as viewing e-mail attachments, even if a particular device is not capable of processing the attachment. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and the search required for Groups I, II, and III are not required for the other groups, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Cochran on April 19, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuki (EP Patent No. 772,327, hereinafter "Sharp"), in view of Deo et al. (U.S. Patent No. 5,973,612, hereinafter "Deo").

In considering claim 1, Sharp discloses a method of replicating data items from a host system (200) to a mobile data communication device (100) comprising the steps of:

detecting an event trigger at the host system (col. 7, lines 10-12);

in response to the trigger, continuously redirecting the data items from the host system to the mobile device (col. 7, lines 13-17, wherein selecting a "time interval" for forwarding implies continuous redirection; col. 9, lines 22-27, 46-52, wherein messages are first stored in mail storage section 204, and then additionally transmitted to the wireless terminal 100);

characterizing the data items, and determining the characterization of the data items (col. 7, lines 18-20; col. 17, lines 11-23); and

receiving redirected data items at the mobile device (col. 9, lines 46-52).

However, Sharp fails to disclose configuring one or more notification types at the mobile device, and notifying the user of the received data items according to a notification type corresponding to the determined characterization of the data items. Nonetheless, notifying a mobile device user of received messages according to a characterization of the messages is well known, as evidenced by Deo. In a similar art, Deo discloses a message paging system, wherein received data items are classified according to various criteria, and wherein a user is notified of receipt of data items according to a notification type that corresponds to the message classification (col. 2, lines 15-56; col. 7, lines 19-21; col. 8, lines 1-2, 15-26). Given the teaching of Deo, a person having ordinary skill in the art would have readily recognized the desirability and advantages of including the message notification taught by Deo for the forwarded

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messages taught by Sharp so that a user can be notified of incoming messages and their priority without having to look at the paging device. Therefore, it would have been obvious to include the notification scheme taught by Deo in the message redirection system taught by Sharp.

In considering claims 2-4, Sharp further discloses the characterization step taking place at the host system (col. 17, lines 11-23), and Deo further discloses characterization of the data items at the mobile device (col. 7, lines 19-38). It would have been obvious to a person having ordinary skill in the art to characterize the forwarded messages disclosed by Sharp, at the mobile device, as disclosed by Deo, so that the user of the mobile device can be kept aware of the most important received messages.

In considering claims 5 and 6, Deo discloses characterizing items based on type, including calendar events, instant notifications, and e-mail (col. 9, lines 9-18; col. 10, lines 60-67). It would have been obvious to a person having ordinary skill in the art to include calendar events and instant notifications in the system taught by Sharp so that a remote user could keep track of important meetings and information in addition to keeping track of important e-mail messages.

In considering claims 7 and 8, both Sharp and Deo disclose characterizing the data items based on various levels of priority (Sharp, col. 17, lines 20-23; Deo, col. 2, lines 15-19).

Claim 9 contains no further limitations over claims 5-8, and is rejected for the same reasons.

In considering claim 10, Sharp further discloses embedding characterization information into the header associated with the data items (Fig. 8).

In considering claim 11, Sharp further discloses that priority is associated with a sender of the data item (col. 17, lines 11-15).

In considering claim 12, Sharp further discloses that priority is associated with a receiver of the data item (col. 17, lines 20-23)

In considering claim 13, Sharp further discloses that priority is associated with a subject of the message (col. 17, lines 16-19).

In considering claims 14-16, Deo further discloses audible, visual, and vibrating notification types (col. 7, lines 20-25).

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In considering claims 17 and 18, Deo further discloses selecting different audible notifications and/or vibrating notifications based on the data item characterization (col. 7, lines 59 – col. 8, line 6).

In considering claim 19, both Sharp and Deo further disclose that the data item type is an E-mail data item (Sharp, Abstract; Deo, col. 9, lines 13-16).

In considering claim 20, Deo discloses that the data item type can be E-mail (col. 9, lines 13-16). It would have been obvious to forward both inbound and outbound messages in the combined system taught by Sharp and Deo so that any changes made at the host system could be forwarded to the mobile device, thus keeping the user informed of all e-mail updates.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 305-7201.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3900.



Dung C. Dinh
Primary Examiner

BE
April 20, 2001

Notice of References Cited

Application/Control No.

09/545,962

Applicant(s)/Patent Under
Reexamination
MAJOR ET AL.

Examiner

Bradley Edelman

Art Unit

2153

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number	Date	Name	Classification	
		Country Code-Number-Kind Code	MM-YYYY			
	A	US-005973612A-	10-1999	Deo et al.	340	825.44
	B	US-006052735A-	04-2000	Ulrich et al.	709	236
	C	US-006138146A-	10-2000	Moon et al.	709	206
	D	US-6185603-B1	02-2001	Henderson et al.	709	206
	E	US- -				
	F	US- -				
	G	US- -				
	H	US- -				
	I	US- -				
	J	US- -				
	K	US- -				
	L	US- -				
	M	US- -				

FOREIGN PATENT DOCUMENTS

*		Document Number	Date	Country	Name	Classification	
		Country Code-Number-Kind Code	MM-YYYY				
	N	- -					
	O	- -					
	P	- -					
	Q	- -					
	R	- -					
	S	- -					
	T	- -					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Briere et al., One mailbox, just like the old times, Network World, Framingham, Apr 21, 1997, Volume 14, pp. 21ff.
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

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FORM PTO-1449 (Modified)
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT
(Use several sheets if necessary)

JUL 31 2000

Atty Docket No.: 555255012125

Serial No.: 09/545,962

Group 2700

Applicant(s): Harry Major; Krishna K. Pathiyal; Gary Mousseau; Mihal Lazaridis

Filing Date: April 10, 2000

Group: 2756

(37 CFR 1.98(b))

U.S. PATENT DOCUMENTS

Exam. Init.	Patent Number								Issue Date	Patentee	Class	Subclass	Filing Date
BE	5	4	3	6	9	6	0	07/25/95	Campana, Jr. et al.				
	5	4	3	8	6	1	1	08/01/95	Campana, Jr. et al.				
	5	4	7	9	4	7	2	12/26/95	Campana, Jr. et al.				
	5	6	2	5	6	7	0	04/29/97	Campana, Jr. et al.				
	5	6	4	1	9	4	6	05/20/97	Campana, Jr. et al.				
	5	8	1	9	1	7	2	10/06/98	Campana, Jr. et al.				
	5	3	9	2	3	9	0	02/21/95	Crozier				
	5	6	6	6	5	5	3	09/09/97	Crozier				
	5	4	9	5	4	8	4	02/27/96	Self et al.				
	5	6	0	3	0	5	4	02/11/97	Theimer et al.				
	5	6	7	3	3	2	2	09/30/97	Pepe, et al.				
	5	7	3	7	5	3	1	04/07/98	Ehley				
	5	7	5	4	9	5	4	05/19/98	Cannon et al.				
	5	3	1	3	5	8	2	05/17/94	Hendel et al.				

FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

Exam. Init.	Document Number								Publication Date	Country or Patent Office	Class	Subclass	Translation	
													Yes	No
BE	9	7	4	1	6	5	4	11/06/97	WO					
	9	7	3	2	2	5	1	09/04/97	WO					
	9	7	3	3	4	2	1	09/12/97	WO					
	9	6	1	9	0	6	4	06/20/96	WO					
	9	7	4	4	9	4	2	11/27/97	WO					
	9	8	2	3	1	0	8	05/28/98	WO					

AUG 07 2000



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U.S. PATENT DOCUMENTS

Exam. Init.	Patent Number	Issue Date	Patentee	Class	Subclass	Filing Date
BE	5 4 1 6 4 7 3	05/16/95	Dulaney, III et al.			
	5 7 9 0 9 7 4	08/04/98	Tognazzini			
	5 8 1 9 2 8 4	10/06/98	Farber et al.			
	5 9 9 5 5 9 7	11/30/99	Woltz et al.			
	6 0 2 3 7 0 0	02/08/00	Owens et al.			
	6 0 5 2 5 6 3	04/18/00	Macko			

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FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

Exam. Init.	Document Number	Publication Date	Country or Patent Office	Class	Subclass	Translation
BE	0 7 7 2 3 2 7	02/17/99	Europe			Yes No
	0 7 7 2 3 2 7	05/07/97	Europe			
	9 7 3 3 4 2 1	09/12/97	WO			

OTHER DOCUMENTS (Including Author, Title, Date, Relevant pages, Place of Publication***)**

Examiner *Bradley Edelman*

Date Considered *4/18/01*

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

FORM PTO-1449 (Modified)
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

INFORMATION DISCLOSURE
STATEMENT BY APPLICANT
(Use several sheets if necessary)

(37 CFR 1.98(b))



Atty Docket No.: 555255012125

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Group: 2756

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U.S. PATENT DOCUMENTS

Technology Center 2100

Exam. Init.	Patent Number								Issue Date	Patentee	Class	Subclass	Filing Date
BE	6	0	0	6	2	7	4		12/21/1999	Hawkins et al.			
BE	6	0	3	4	6	2	1		03/07/2000	Kaufman			
BE	5	7	2	7	2	0	2		03/10/1998	Kucala			
BE	6	0	0	0	0	0	0		12/07/1999	Hawkins et al.			

FOREIGN PATENT OR PUBLISHED FOREIGN PATENT APPLICATION

Exam. Init.	Document Number								Publication Date	Country or Patent Office	Class	Subclass	Translation	
													Yes	No

OTHER DOCUMENTS (Including Author, Title, Date**, Relevant pages, Place of Publication***)

BE	Feibus, "A Desktop In Your Palm", Informationweek, Aug. 25, 1997, pages 65ff.
BE	Behr, "Handheld Solutions", Informationweek, Oct. 27, 1997, pages 106-113.

Examiner *Bradley Edelman*

Date Considered *4/18/01*

EXAMINER: Initial citation considered. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.